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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/857,043	08/02/2001	Takayuki Doki	TMI-103	7787

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EXAMINER

HEWITT II, CALVIN L

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 01/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/857,043	Applicant(s) DOKI, TAKAYUKI	
	Examiner Calvin L. Hewitt II	Art Unit 3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 November 2005.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 34-36 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 34-36 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Status of Claims

1. Claims 34-36 have been examined.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claim 36 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 36 recites a media comprising an information terminal, however, Applicant's Specification merely discloses media comprising a floppy, portable terminal ID, IC card or other digital media.

For purposes of examination, the Examiner is interpreting the language of claim 36 as follows: wherein the media comprises an IC card.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 34-36 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a. Applicant's system, as defined by claim 34, comprises a settlement terminal device configured to transmit balance information equivalent to an amount of money paid where an amount money, equal to a service amount, is subtracted from the balance information after it is been determined that a service can be provided. However, one of ordinary skill does not see how this can be done as "the balance of information equivalent to an amount of money paid" is not actual money but mere bits of data.

Claims 35-36 are also rejected as they depend from claim 34.

b. Claim 34 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01. The omitted elements are: transmitting balance and ID information from the terminal device to the settlement management device.

Claims 35-36 are also rejected as they depend from claim 34.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 34-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stimson et al., U.S. Patent No. 5,511,114 in view of Reese, U.S. Patent No. 4,969,183 and Walker, U.S. Patent No. 5,825,863.

As per claims 34-36, Stimson et al. teach a settlement system comprising:

- a settlement terminal device configured to read, at the time of settlement of media, an ID number (sub-ID number), unique to each media, and balance information and to transmit the ID number and balance information to a management device (figure 1; column 4, lines 17-43)
- a settlement device that can transmit deposit information (figures 1-3)
- a management device for validating the ID number (column 5, lines 29-31) and transmitting data to one of a plurality authentication devices based on service specification information (i.e. phone number called) transmitted from the terminal device (column 5, lines 30-35)

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- transmitting data from a service selection device to one of a plurality of authentication devices based on service information transmitted from the terminal device (i.e. number called) (column 5, lines 30-35)

However, Stimson et al. do not specifically recite an authentication device determining whether a service can be provided. Reese teaches an authentication device that receives an ID number and balance information (e.g. deposit information) and determines whether a service can be provided (figures 1A-2) and processes a payment received from a customer for providing said service (column 4, lines 3-23; column 5, lines 3-18). Further, the authentication device of Reese also stores customer specific information such as ID numbers (e.g. sub-ID numbers) that are associated with a customer's balance information (column 3, lines 8-12), queries a settlement management device in order to validate an ID, (column 4, lines 3-23) and prohibits service if the ID number is not validated or the amount is smaller than a current balance (column 4, lines 3-23). Stimson et al. teach a system that allows a customer to pay for a call using a calling card (abstract) while Reese provides customers with a phone service such as telephone lotto (abstract). Specifically, Reese allows users to pay for said service using a calling card (column 2, lines 42-53). Therefore, it would have been obvious to allow users to pay for the services of Reese using the calling card of

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Stimson et al.. However, Stimson et al. do not explicitly recite calling card accounts that store money. Walker et al. teach a calling card account that stores monetary value (column 4, lines 36-43). Therefore, it would have been obvious to one of ordinary skill to combine the teachings of Stimson et al., Reese, and Walker in order to allow customers to pay for multiple services (e.g. telephone calls and gaming) using a single card.

As per claims 35 and 36, claim 34 is directed to a settlement system comprising a settlement terminal device, one or more authentication devices and a settlement management device. Therefore, limitations directed to a media is non-functional as it does not alter the way the system performs to achieve the utility of the invention and does not distinguish Applicant's system from the prior art. Further, the Examiner takes Official Notice that it is well known to distribute cards via a slip or where the media is supplied on separable sheets (i.e. printed). Further, the cards of Stimson et al., have memory and may be a "smart card", therefore, media (i.e. cards) of Stimson et al. comprise an information processor or device (i.e. terminal). Regarding the term "adapting", a recitation directed to the manner in which a claimed apparatus is intended to be used, does not distinguish the claimed apparatus from the prior art, if the prior art has the capability to so perform (MPEP 2100-8, first column; MPEP 2114, *Ex parte Masham*, 2 USPQ2d 1647 (1987)).

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Calvin Loyd Hewitt II whose telephone number is (571) 272-6709. The Examiner can normally be reached on Monday-Friday from 8:30 AM-5:00 PM.

If attempts to reach the Examiner by telephone are unsuccessful,

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the Examiner's supervisor, James P. Trammell, can be reached at (571) 272-6712.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

c/o Technology Center 3600

Washington, D.C. 20231

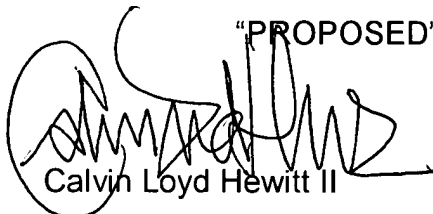
or faxed to:

(571) 273-8300 (for formal communications intended for entry and after-final communications),

or:

(571) 273-6709 (for informal or draft communications, please label

"PROPOSED" or "DRAFT")



Calvin Loyd Hewitt II

January 20, 2006